

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

RYONO, ET AL

PATENT NO: 7,557,143

ISSUED: July 7, 2009

FOR: THYROID RECEPTOR LIGANDS

FILED VIA USPTO EFS-WEB

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PERIOD
IN GRANTED PATENT UNDER 37 C.F.R. §§ 1.181 & 1.705(d)

Sir/Madam:

This is a request for reconsideration of the patent term adjustment for the captioned patent.

Statement of the Facts

As required under 37 C.F.R. § 1.705(b)(2), Applicant provides the following statement of the facts involved.

The patent term adjustment history from PAIR shows a USPTO delay of 682 days and Applicant's delay of 29 days. This delay is calculated as follows:

USPTO Delay:

12-05-2006	Mail Restriction Requirement	538 days
12-07-2007	Mail Final Rejection	43 days
02-26-2009	Mail Notice of Allowance	<u>101 days</u>
		682 days

APPLICANT DELAY:

06-25-2007	Response after Non-Final Action	2 days
04-03-2008	Request for Continued Examination	<u>27 days</u>
		29 days

However, as indicated below, the period of USPTO delay for calculating the patent term adjustment should be the sum of the 354 days of patent term adjustment due to exceeding the three year pendency plus the 682 days due to USPTO delay in prosecution, minus the 29 days of applicant delay which results in 1007 days of Patent Term Adjustment.

35 U.S.C. § 154(b) provides for adjustment of patent term due to certain delays of the USPTO. This includes the “A period” of 35 U.S.C. § 1.54(b)(1)(A) (concerning failure of the USPTO to comply with deadlines enumerated therein) and the “B period” of 35 U.S.C. § 1.54(b)(1)(B) (concerning failure of the USPTO to issue a patent within 3 years of filing).

In *Wyeth v. Dudas* (2008 WL 4445642 (D.D.C. September 30, 2008), the United States District Court of the District of Columbia rejected the USPTO’s view¹ that any administrative delay under the “A period” (35 U.S.C. § 154(b)(1)(A) period) overlays any 3-year maximum pendency delay under the “B period” (35 U.S.C. § 154(b)(1)(B) period) (i.e., that applicant gets credit for “A period” or for “B period,” whichever is larger, but never “A period” + “B period”). Rather, the *Wyeth* court held that the “A period” (35 U.S.C. § 1.54(b)(1)(A)) and the “B period” (35 U.S.C. § 1.54(b)(1)(B)) overlap *only* if they occur on the *same calendar day or days*. In view of the *Wyeth* decision,

¹ See, 69 Fed. Reg. 34238 (2004).

Applicant submits this request for reconsideration of the patent term adjustment period.

In the instant case, the “A period” (35 U.S.C. § 154(b)(1)(A) period) and “B period” (35 U.S.C. § 154(b)(1)(B) period) do not occur on the same calendar day or days. In particular, the 354 day USPTO delay occurring in the “B period” (beginning April 15, 2007, three years after the patent application was filed, and ending on April 03, 2008) when the Request for Continued Examination was filed does not overlap the USPTO “A period” delay of 682 days.

Accordingly, in view of *Wyeth*, Applicant is entitled to the combination of the “A period” 682 days plus the “B period” 354 days, minus the 29 day applicant delay. The 1007 days does not include the period beginning on April 3, 2008 (the date on which an RCE was filed) and ending on July 7, 2009 (the issue date). Applicant requests reconsideration of the patent term adjustment period to 1007 days.

The patent is not subject to any terminal disclaimer that would impact such a correction. In addition, there are no circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704.

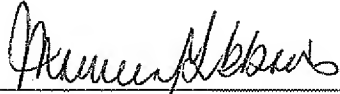
Timeliness of this Request

As this request is being filed within two months of the patent’s issue date, it is timely under 37 C.F.R. § 1.705(d).

Request Fee

As required under 37 C.F.R. § 1.705(b)(1), please charge the fee prescribed in 37 C.F.R. § 1.18(e) to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company. Please charge any additional fees, or credit any overpayment, to the same account.

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